



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/979,570	11/26/2002	Marvin A. Frankel	MAF-10002/22	6028

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EXAMINER

AUGUSTIN, EVENS J

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/979,570

Applicant(s)

FRANKEL, MARVIN A.

Examiner

Evens Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

This is in response to an amendment file on 04/19/2006 for letter for patent filed on 04/19/2006. In the amendment, claims 1, 2, 8 and 9 have been amended. Claims 1-9 are pending in the letter.

***Response to Arguments***

1. The United States Patent and Trademark Office has fully considered the applicant's arguments on 04/19/2006, but has not found those arguments to be persuasive.

**Argument 1:** Prior Art does not teach the aspects of a true anonymous transaction as customer information can be recreated

**Response 1:** According to claim 1 of the applicant's application, anonymity is ensured by creating a customer number corresponding to the amount being purchased. Similarly, the prior art teaches the generation of a customer number that gets presented during a transaction, and is subsequently reconciled to complete the transaction (column 3, lines 40-47, column 4, lines 25-29). Applicant makes the assertion that employees of the clearinghouses or banks could reveal customer's identity. Firstly, the customer **may pay cash for the receipt of the anonymous number** that will be used in the transaction (column 4, lines 16-19). Secondly, in an alternative embodiment, the prior art **does not use clearinghouses but uses encryption**. A private key/public key pair and a secret encoding key will be used in this invention. The use of private key/public key pairs and the use of secret encoding keys are now well known (column 2, lines 25-30). Therefore, customer's identity is truly anonymous.

***Status of Claims***

2. Claims 1-9 have been examined.

***Objections***

3. The abstract is objected to because of the following informalities:

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given. The current abstract is a copy of PCT abstract and includes a drawing. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shub et al. (U.S. 6807530), in view of O'Leary et al. (U.S. 6609113).

As per claims 1-9, Shub et al. disclose an invention that relates to techniques for controlling and limiting the flow of identification information in a commercial transaction, and more particularly to a method and apparatus which enables customers to remotely order goods from a merchant and receive the goods without revealing the customer's identity or address to the merchant. The invention comprises of the following:

- The transacting parties include the customer's bank/payment agencies, merchant and clearinghouses (column 2, lines 16-18)
- Before transacting, the customer gets a customer number/identifier from the customer's payment agency (bank or credit card company) (column 3, lines 40-47)
- Customer submitting the customer number to the online merchant (column 4, lines 25-29)
- Merchant in collaboration with a clearinghouse authenticate the buyer/customer's number (including verification of the customer's financial institution and availability of funds) (column 4, lines 40-46)
- The customer deposits/pays cash to the financial institution in exchange for an identifier (column 4, lines 10-17)
- A computer handling transactions and orders (column 4, line 53). It is inherent that a computer handling transactions will contain a computer readable medium

Shub et al. did not explicitly teach an invention in which there's an Electronic Funds Transfer (EFT) from the user/customer/buyer's account to the merchant account. However, O'Leary et al. describe a system that relates to systems and methods for conducting electronic commerce, and more particularly to systems and method in which a payor pushes electronic

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credits to a payee using an Electronic Funds Transfer system. According to O'Leary et al.'s the user is able to transfer funds from his/her bank account to another account made specifically for internet related transactions (column 16, lines 18-35). The transfer of funds takes place anonymously, with the recipient of the credit having no way to determine from where the credit originated. The recipient of the credit is able to match the received credit with a proposed purchase using a transaction ID that is contained in the EFT (column 14, lines 55-59). After a transaction, the funds get deposited from the user's account with an internet entity (seller) to the merchant's bank account (column 17, lines 10-45). Therefore, it would have been obvious for an artisan skilled in the art to combine Shub et al.'s invention with O'Leary et al.'s systems and methods because it would provide a safe, sound, and secure method that allows users (consumers) to shop on the Internet, pay bills, and pay anyone virtually anywhere, all without the consumer having to share account number information with the payee. Merchants receive immediate payment confirmation through the Electronic Funds Transfer. (EFT) network so they can ship their product with confidence that the payment has already been received (column 4, lines 43-50).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant's amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on 10am - 6pm M-F.

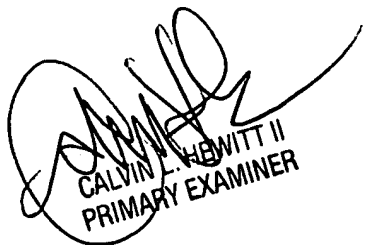
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-671209.

Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin  
July 20, 2006  
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CALVIN L. HEWITT II  
PRIMARY EXAMINER